

REMARKS

Prior to entry of this amendment, claims 1-31 are currently pending in the subject application. Claims 9-15 and 22-28 are withdrawn from consideration. By this amendment, claims 1, 4, 17, and 18 are amended, and claims 1-8, 16-21, and 29-31 are presented to the Examiner for further consideration on the merits.

Applicants note with appreciation the Examiner's acknowledgement of applicants' claim for foreign priority and receipt of a certified copy of the priority document.

Applicants note with appreciation the Examiner's acceptance of the drawings filed on August 4, 2003.

Applicants note with appreciation the Examiner's consideration of applicants' Information Disclosure Statements filed August 4, 2003, November 20, 2003, July 29, 2004, and September 14, 2005.

A. Introduction

In the outstanding Office action, the Examiner rejected claims 5-8 and 19-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; rejected claims 1, 3, 4, 17, 18, and 29 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,253,097 to Aronow et al. (hereinafter referred to as "the Aronow et al. reference"); rejected claims 1, 2, and 30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,606,509 to Schmitt (hereinafter referred to as "the Schmitt reference"); rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the Schmitt reference in view of U.S. Patent No. 4,580,574 to Gavish (hereinafter referred to as "the Gavish reference"); rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over the Schmitt reference and further in view of U.S. Patent No. 5,427,093 to Ogawa et al. (hereinafter referred to as "the Ogawa et al.

reference”); rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference in view of the Gavish reference; rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference and further in view of the Ogawa et al. reference; rejected claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference in view of the Schmitt reference; indicated that claims 7, 8, and 21 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, first paragraph, and to include all the limitations of the base claim and any intervening claims; and objected to claim 16 as being dependent upon a rejected base claim, but indicated that it would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These rejections are respectfully traversed for at least the following reasons.

B. Asserted Indefiniteness Rejections of Claims 5-8 and 19-22

In the outstanding Office action, the Examiner rejected claims 5-8 and 19-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In response, applicants respectfully direct the attention of the Examiner to the section of the specification describing the pressure application unit, on page 17 in paragraph [0037]:

The pressure application unit 53 includes a bolt 52 and a nut 54. The bolt 52 and the nut 54 are screw coupled. When the bolt 52 is turned, the nut moves downwardly in a vertical direction, preferably, along the optical axis that optically connects a center of the light source unit 58 and a center of the photodetector unit 60. Alternatively, the bolt 52 and the nut 54 may be formed as an integrated single body that moves vertically along the optical axis. In this case, when the bolt 52 and the nut 54, which are combined together, are turned in the same direction, the nut 54 engages a threaded portion (not shown) formed on an inner wall of the body 50. The pressure application unit 53 may be pushed manually by the subject or may be engaged automatically when the object 62 reaches a given position in the probe.

In regard to the Examiner's statement that "it is unclear how the pressure application unit applies pressure to the body using the nut and bolt method," applicants respectfully direct the attention of the Examiner to independent claims 1 and 17, both of which recite "applying pressure to the object via the light source unit." As depicted in Figure 2, the object 62 is placed under the pressure application unit 53, which includes the bolt 52 and nut 54. Pressure is applied via the light source unit 58, which is separated from the pressure application unit 53 by the heat dissipating plate 56. This heat dissipating plate 56 also acts as a supporting member for the pressure application unit 53. The nut 54 engages a threaded portion formed on an inner wall of the body 50, thereby coupling the nut-bolt combination to the overall structure. Therefore, applicants respectfully submit that the specification is fully enabling of the limitations recited in claims 5-8 and 19-22. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claims 5-8 and 19-22 under 35 U.S.C. § 112, first paragraph.

C. Asserted Anticipation Rejection of Claims 1, 3, 4, 17, 18, and 29

In the outstanding Office action, the Examiner rejected claims 1, 3, 4, 17, 18, and 29 under 35 U.S.C. § 102(b) as being anticipated by the Aronow et al. reference.

As amended, independent claims 1 and 17 now recite, in part,

-- wherein the pressure application unit is always on a vertical line passing through the light source unit and the photodetector unit --.

No new matter is introduced by this amendment. Support may be found in the specification, for example, on page 16 in paragraph [0035]:

It is preferable that the photodetector unit 60 and the light source unit 58 are arranged in the same optical axis, i.e., they are coaxially arranged.

Further support appears on pages 16-17 in paragraph [0036]:

For this purpose, a pressure application unit 53 for applying a predetermined amount of pressure to a given portion of the object 62, via the light source unit 58, is positioned above the light source unit 58.

From this, it is clear that the pressure application unit 53 is always on a vertical line passing through the light source unit 58 and the photodetector unit 60, as clearly depicted in Figure 2. As the light source and photodetector units are coaxially arranged in the same optical axis, the pressure application unit 53 is aligned in the optical axis above the light source unit.

Applicants respectfully submit that the Aronow et al. reference fails to disclose, or even suggest, each and every element of independent claims 1 and 17. As depicted in FIG. 3, the Examiner identified spring 314 as equivalent to the claimed pressure application unit. This spring, however, is not on a vertical line passing through a light source unit and a photodetector unit. Instead, the position of spring 314 is considerably offset relative to a line between optical port 332 and light detector 333. In the present invention as claimed, the pressure application unit is always on a vertical line passing through the light source unit and the photodetector. Accordingly, applicants respectfully submit that these claims are allowable over the Aronow et al. reference. Therefore, applicants respectfully request favorable reconsideration and withdrawal of the rejections of independent claims 1 and 17 under 35 U.S.C. § 102(b) based on the Aronow et al. reference.

Claims 3 and 4 depend from independent claim 1. Hence, claims 3 and 4 are at least allowable as depending from an allowable base claim, namely independent claim 1, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claims 3 and 4 under 35 U.S.C. § 102(b) based on the Aronow et al. reference.

Claims 18 and 29 depend from independent claim 17. Hence, claims 18 and 29 are at least allowable as depending from an allowable base claim, namely independent claim 17, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claims 18 and 29 under 35 U.S.C. § 102(b) based on the Aronow et al. reference.

D. Asserted Anticipation Rejection of Claims 1, 2, and 30

In the outstanding Office action, the Examiner rejected claims 1, 2, and 30 under 35 U.S.C. § 102(e) as being anticipated by the Schmitt reference.

As amended, independent claims 1 and 17 now recite, in part,

-- wherein the pressure application unit is always on a vertical line passing through the light source unit and the photodetector unit --.

No new matter is introduced by this amendment. Support may be found in the specification and drawings, as described in Section C above.

Applicants respectfully submit that the Schmitt reference fails to disclose, or even suggest, each and every element of independent claims 1 and 17. As depicted in FIG. 6, the Examiner identified clamp 602 as equivalent to the claimed pressure application unit. This clamp, however, is not on a vertical line passing through a light source unit and a photodetector unit. Instead, the position of clamp 602 is considerably offset relative to a line between LED sources 610 and photodetector 608. In the present invention as claimed, the pressure application unit is always on a vertical line passing through the light source unit and the photodetector. Accordingly, applicants respectfully submit that these claims are allowable over the Schmitt reference. Therefore, applicants respectfully request favorable reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 102(b) based on the Schmitt reference.

Claim 2 depends from independent claim 1. Hence, claim 2 is at least allowable as depending from an allowable base claim, namely independent claim 1, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. § 102(e) based on the Schmitt reference.

Claim 30 depends from independent claim 1. Hence, claim 30 is at least allowable as depending from an allowable base claim, namely independent claim 1, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claim 30 under 35 U.S.C. § 102(e) based on the Schmitt reference.

E. Asserted Obviousness Rejection of Claim 5

In the outstanding Office action, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the Schmitt reference in view of the Gavish reference.

Claim 5 depends from independent claim 1. Hence, claim 5 is at least allowable as depending from an allowable base claim, namely independent claim 1, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. § 103(a) over the Schmitt reference in view of the Gavish reference.

F. Asserted Obviousness Rejection of Claim 6

In the outstanding Office action, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over the Schmitt reference and further in view of the Ogawa et al. reference.

Claim 6 ultimately depends from independent claim 1. Hence, claim 6 is at least allowable as depending from an allowable base claim, namely independent claim 1, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claim 6 under 35 U.S.C. § 103(a) over the Schmitt and Gavish references, further in view of the Ogawa et al. reference.

G. Asserted Obviousness Rejection of Claim 19

In the outstanding Office action, the Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference in view of the Gavish reference.

Claim 19 depends from independent claim 17. Hence, claim 19 is at least allowable as depending from an allowable base claim, namely independent claim 17, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. § 103(a) over the Aronow et al. reference in view of the Gavish reference.

H. Asserted Obviousness Rejection of Claim 20

In the outstanding Office action, the Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference and further in view of the Ogawa et al. reference.

Claim 20 ultimately depends from independent claim 17. Hence, claim 20 is at least allowable as depending from an allowable base claim, namely independent claim 17, which includes allowable subject matter that is neither taught nor suggested in the references of record.

Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claim 20 under 35 U.S.C. § 103(a) over the Aronow et al. and Gavish references, further in view of the Ogawa et al. reference.

I. Asserted Obviousness Rejection of Claims 30 and 31

In the outstanding Office action, the Examiner rejected claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference in view of the Schmitt reference.

Claims 30 and 31 ultimately depend from independent claim 17. Hence, claims 30 and 31 are at least allowable as depending from an allowable base claim, namely independent claim 17, which includes allowable subject matter that is neither taught nor suggested in the references of record. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claims 30 and 31 under 35 U.S.C. § 103(a) over the Aronow et al. reference in view of the Schmitt reference.

J. Allowable Subject Matter

Applicants note with appreciation the Examiner's indication of allowable subject matter in claims 7, 8, 16, and 21.

K. Conclusion

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

Respectfully submitted,

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PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.